

REMARKS

Claims 1, 3-4, 7-13, and 21-28 are pending. Claims 14-22 have been cancelled as they are drawn to a non-elected invention. Claims 2, 5 and 6 have been cancelled. Claims 1 and 3-4 have been amended to clarify the scope of the invention.

The issue outstanding in this application is as follows:

- Claims 1, 3-4, 7-13, and 21-28 are rejected under 35 U.S.C. § 102(b) as being anticipated by Gordon (US 5,892,577).

Applicant traverses the rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

Below is a chart showing individual limitations in claim 1 and the element(s) cited from Gordon as corresponding to the limitation:

CLAIM 1	GORDON ELEMENT	COMMENTS
a disc with an axis of symmetry and at least one detection area each of which represents a subarea within a detection microcavity	NONE	See next row.

said microcavity being part of a microchannel structure in which aliquots of liquid can be transported and processed	NONE	The Examiner refers to the use of electrophoretic gels polymerized on top of a disc as supplying this element. OA 11-29-05, pg 4, para. 3. Microcavities and Microchannel structures are described in the Specification at [0076] – [0081]. The electrophoretic gel overlay of Gordon does not anticipate these structures.
a detector head with a focal area that has dimensions such that it is capable of covering only a part of the detection area	Bight 46 of U-shaped arm 36	Col. 8, l. 59: “[t]he bight of 46 of the arm 36.” Element 46 is the bend in the arm 36 structure. A detector head is defined in the Specification at [0063] – [0075]. Bight 46 does not anticipate this limitation.

The Examiner has additionally rejected the dependent limitations in claims 3, 4, 7-13 which depend on claim 1. For the same reasons as discussed for claim 1, these claims are not anticipated by Gordon. Additionally, the dependent limitations are also lacking in Gordon:

Claim 3: wherein said detector head is capable of use in laser induced fluorescence	Laser light source 8 & Col. 1, para. 3.	The fluorescence in Col. 1, para. 3 refers to fluorescent staining of biological antigen materials. This does not necessarily require laser induced fluorescence and is not an element of the Gordon invention,
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		<p>but rather background information. Laser induced fluorescence is not explicitly described in Gordon. Nothing in Gordon can be construed to mean that Gordon <i>necessarily</i> has the capacity to employ laser induced fluorescence during its operation.</p>
Claim 12: wherein said plastic material is black	Black bar 50	<p>The Examiner insists that a black bar on a transparent plastic disk (Col. 9, ll. 5-7) anticipates a disk made of black colored plastic. The argument that the claimed disk could comprise additional colors from other materials is irrelevant. OA 11-29-05, pg 4, para. 3. The limitation is that the plastic used to fabricate the disk be black. Gordon has no such disclosure.</p>
Claim 13: wherein said substance has been immobilized in the detection microcavity during flow conditions while liquid is passing through the microcavity as part of said transportation and processing.	NONE	<p>The flow conditions occur during the transportation and processing of samples through the microstructures of the microfluidic disk. According to the Examiner, Gordon teaches substances immobilized on a disk throughout operation of the device. The Examiner concludes from this that because particular flow conditions are not defined in the claim, "it must be concluded that</p>

		<p>the limitation ...is fully satisfied by the Gordon device.” There is no logical connection between the presence of immobilized substances in Gordon and the existence of flow conditions during the immobilization process. The Examiner’s rationale does not meet the initial burden of establishing anticipation by inherency.</p>
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The Examiner failed to specifically address new claims 21-28. To the degree these claims overlap with the above discussed limitations, these claims are also not anticipated by Gordon. Further, the claims contain additional limitations which the Examiner has not addressed. Rejection of these claims is therefore improper substantively and procedurally.

Applicant notes that the text of the Examiner’s office action rejects claims 5 and 6. These claims have been canceled.

In view of the above, Applicant requests all rejections be withdrawn. Applicant believes the pending application is in condition for allowance.

A Request for Continued Examination with fee is enclosed herewith. Applicant believes no other fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2375, under Order No. HO-P02314US1 from which the undersigned is authorized to draw.

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Respectfully submitted,

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